

Docket No.: 271783US0PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: :
Yoshiaki KUMAMOTO, et al. : EXAMINER : FORTUNA, J.A.
SERIAL NO: 10/534,047 :
FILED: NOVEMBER 22, 2005 : ART UNIT: 1791
FOR: MOLDED SHEET

PETITION UNDER 37 C.F.R. §1.181(a)(3)

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Petitioners respectfully request the Office to invoke the supervising authority of the Commissioner and compel proper consideration of CN 1196671, which was cited on an IDS filed on October 26, 2007.

The facts in this case are as follows:

- On October 26, 2007, an IDS was filed citing CN 1196671. Together with this IDS a Chinese Office Action that cited this reference and an English translation thereof was filed.
- On June 13, 2008, together with the Office Action, the Examiner provided a copy of the IDS filed on October 26, 2007, where CN 1196671 was stricken through as not having been considered. The basis for non-consideration was stated as “No translation nor statement of relevancy.”
- During a review of this application prior to payment of the Issue Fee, the Examiner’s non-consideration of CN 1196671 was identified.

- A phone message with the Examiner was left on March 19, 2010, requesting consideration of CN 1196671 in view of MPEP §609.04(a)(III).
- This phone message was not returned and no further action has been taken by the Office with respect to CN 1196671.
- CN 1196671 corresponds to US 6,127,294, which was cited by the Examiner during prosecution (See PTO-892 mailed June 13, 2008), and EP 0856302, which was cited by Petitioners in an IDS filed on December 21, 2007 and acknowledged as being considered on June 13, 2008.

Petitioners submit that non-consideration of CN 1196671 is procedurally improper and request acknowledgment of consideration of this reference.

Each information disclosure statement must further include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information listed that is not in the English language. The concise explanation may be either separate from the specification or part of the specification. (37 C.F.R. §1.98(a)(3)(1)). MPEP §609.04(a)(III) defines the concise explanation as follows:

The requirement for a concise explanation of relevance is limited to information that is not in the English language. The explanation required is limited to the relevance as understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information at the time the information is submitted to the Office. If a complete translation of the information into English is submitted with the non-English language information, no concise explanation is required. An English-language equivalent application may be submitted to fulfill this requirement if it is, in fact, a translation of a foreign language application being listed in an information disclosure statement. There is no requirement for the translation to be verified. Submission of an English language abstract of a reference may fulfill the requirement for a concise explanation. ***Where the information listed is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by***

submitting an English-language version of the search report or action which indicates the degree of relevance found by the foreign office. This may be an explanation of which portion of the reference is particularly relevant, to which claims it applies, or merely an "X", "Y", or "A" indication on a search report. The requirement for a concise explanation of non-English language information would not be satisfied by a statement that a reference was cited in the prosecution of a United States application which is not relied on under 35 U.S.C. 120. (emphasis added)

In this case, CN 1196671 was filed together with an English translation of the Chinese Office Action discussing this reference. As such, the requirements of 37 C.F.R. §1.98(a)(3)(1) have been met and consideration by the Examiner is compelled. Further, two references that correspond to CN 1196671 have been cited and consider by the Examiner.

In view of the foregoing, Petitioners respectfully request that the Examiner acknowledge consideration of CN 1196671 by providing Petitioners with an initialed copy of the Form PTO-1449 filed on October 26, 2007 listing this reference.

For the reasons given above, this petition should be GRANTED.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, L.L.P.
Norman F. Oblon



Vincent K. Shier, Ph.D.
Registration No. 50,552

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413-2220
(OSMMN 08/03)